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30 DEC 1996  
30 DEC 1996  
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In re Application of  
Paul M. DeFourny et al  
Application No.: 08/696,986  
PCT No.: PCT/GB95/00181  
Int. Filing Date: 30 January 1995  
Priority Date: 04 February 1994  
Attorney's Docket No.: DBS-38  
For: DRILLING BIT ASSEMBLY  
AND APPARATUS

:  
: DECISION ON  
:  
: PETITION  
:  
: UNDER 37 CFR 1.47(a)  
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This is in response to the petition under 37 CFR 1.47(a), filed 02 August 1996, to permit the signing joint inventors to file the above-captioned application on their own behalf and on behalf of the non-signing joint inventor Paul Defourny.

BACKGROUND

On 30 January 1995, applicants filed international application PCT/GB95/00181, which claimed priority of an British application filed 04 February 1994. A Demand for international preliminary examination, in which the United States was elected, was filed on 24 August 1995. Accordingly, the thirty-month period for paying the basic national fee in the United States expires at midnight on 05 August 1996 (04 August 1996 was a Sunday).

On 02 August 1996, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the basic national fee. To satisfy the requirements of 35 U.S.C. 371(c)(4), applicants filed on 02 August 1996 the following papers:

- 1) a transmittal letter;
- 2) a petition under 37 CFR 1.47(a) and required fee;
- 3) a declaration signed by the joint inventor Fereidonn Abbassian;
- 4) a declaration signed by G. DeChief, Managing Director of the alleged assignee DB Statabit, S.A., setting forth the steps attempting to obtain Mr. DeFourny's signature.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. The petition is missing items (2) and (3) above.

Regarding item (2) above, Mr. DeChief has stated that he sent copies of the declaration via certified mail to Mr. DeFourny

Applicants have not proven that a diligent effort has been made to reach the inventors. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventors for signature. Mr. DeChief's statement does not state that a complete copy of the application papers was sent to Mr. DeFourny. Applicants have not presented any evidence that Mr. DeChief followed up the letters with further letters or telephone calls to see if Mr. DeFourny would sign the papers.

Regarding item (3) above, applicants have not indicated the complete address for Mr. DeFourny. Mr. DeFourny's address did not include the country.

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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